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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,636	10/06/2003	Peter Ernest Page	0730.0063C	7805

27896 7590 08/25/2006

EDELL, SHAPIRO & FINNAN, LLC  
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SUITE 400  
ROCKVILLE, MD 20850

EXAMINER
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COY, NICOLE A

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/678,636	PAGE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nicole Coy	3672	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-106 is/are pending in the application.
- 4a) Of the above claim(s) 1-91 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 92-106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/6/06</u>  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 1-91 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/6/06.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "62" has been used to designate both completion string and shaped shoulder. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3672

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 98-102 rejected under 35 U.S.C. 102(b) as being anticipated by Haeber (USP 3,256,937).

With respect to claim 98, Haeber discloses a method comprising: coupling a tubing string with a Christmas tree above water; and landing the Christmas tree on a subsea wellhead (see column 1 lines 61-65).

With respect to claim 99, Haeber discloses that coupling the tubing string with the Christmas tree comprises installing a tubing hanger on an uppermost joint of the tubing string and locking the tubing hanger to the Christmas tree (see column 1 lines 61-65; wherein in order to couple the tubing string to the tree requires a tubing hanger).

With respect to claim 100, Haeber discloses running the Christmas tree, the tubing hanger, and the tubing string open-water to a well extending from the subsea wellhead (see column 1 lines 61-65).

With respect to claim 101, Haeber discloses that running the Christmas tree, the tubing hanger, and the tubing string further comprises running the Christmas tree, the tubing hanger, and the tubing string without a blow-out preventer (see column 1 lines 61-65, wherein a BOP is not used).

With respect to claim 102, Haeber discloses coupling the tubing string with the Christmas tree comprises installing a tubing hanger on an uppermost joint of the tubing string, locking the tubing hanger in a tubing spool, and attaching the tubing spool to the Christmas tree (see column 1 lines 61-65).

5. Claims 103-106 are rejected under 35 U.S.C. 102(e) as being anticipated by Bartlett (USP 7,063,157).

With respect to claim 103, Bartlett discloses a method comprising: coupling a tubing string (50) with a tubing hanger (48) above water; landing the tubing hanger on a subsea wellhead (see figure 6 and column 4 lines 40-57); and landing a Christmas tree (22) on the subsea wellhead (see column 4 lines 58-67).

With respect to claim 104, Bartlett discloses latching the tubing hanger (48) to the Christmas tree (22) (see figure 11I).

With respect to claim 105, Bartlett discloses latching the tubing hanger (48) to the wellhead (20) (see column 6 lines 24-40).

With respect to claim 106, Bartlett discloses landing the tubing hanger (48) on the subsea wellhead (20) further comprises landing the tubing hanger on the subsea wellhead via a tubing spool and latching the tubing hanger to the tubing spool (see figure 11E, wherein the wellhead inherently has a tubing spool).

***Claim Rejections - 35 USC § 103***

Art Unit: 3672

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 92-97 rejected under 35 U.S.C. 103(a) as being unpatentable over Haeber.

With respect to claim 92, Haeber discloses a method of completing a sub-sea well using a horizontal christmas tree for production flow control, the horizontal christmas tree having a body, the method comprising the steps of: forming an assembly by installing a completion string terminating at its upper end in and suspended from a tubing hanger in the body of christmas tree; and, running the assembly to the sub-sea well, the method characterised in that the tubing hanger and the horizontal christmas tree are above the water-line during the step of forming the assembly (see column 1 lines 61-65, wherein a tubing hanger would be present in order to connect the tubing to a Christmas tree). Haeber is silent as to the type of christmas tree. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Haeber by using a horizontal christmas tree in order to use less vertical space on both on the rig and in the well.

With respect to claim 93, Haeber discloses the step of forming the assembly further comprises the steps of landing and locking the tubing hanger in the body of the christmas tree (wherein a tubing hanger would be present).

With respect to claims 94 –96, Haeber does not disclose the step of verifying the integrity of the completed assembly above the water line. However, it would have been obvious to modify Haeber in order to verify the integrity of the completed assembly in order to make sure that everything was working before running the assembly to its position on the ocean floor.

With respect to claim 97, Haeber does not disclose the step of running the assembly to the well head comprises the step of using a lower-riser package. However, lower-riser packages are well known in the prior art for running assemblies to the wellhead. It would have been obvious to one having ordinary skill in the art at the time of the invention to include a lower-riser package.

### ***Conclusion***


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole Coy whose telephone number is 571-272-5405. The examiner can normally be reached on M-F 7:30-5:00, 1st F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

nac

  
William Neuder  
Primary Examiner